

Appl. No. 10/785,316  
Amendment dated October 17, 2005  
In Response to Office Action of May 16, 2005

**REMARKS/ARGUMENT**

These remarks are submitted in reply to the Office Action mailed May 16, 2005. In that Office Action, the Examiner rejected claims 1-10 and 13-22 under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,628,509 (*Christian*) in view of U.S. Patent No. 6,500,079 (*Tucker, Sr.*).

The Applicant has amended independent claims 1, 9, 13 and 21 to provide that the main body portion and the rib portion of the hockey stick shaft form a single, unitary part. Each of the dependent claims 2-7, 10, 14-20 and 22 are to be construed as incorporating all of the limitations of independent claim 1 to which they refer. 35 U.S.C. § 112. Therefore, if the independent claims distinguish patentably from the prior art and are allowable, then each of the respective trailing dependent claims must so distinguish and be allowable. *See, e.g., In re Fine*, 837 F.2d 1071, 1076, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

*Ex Parte Douglas J. Herst* (Bd. Pat. App. & Interf., Appeal No. 1998-2376), relates to a product-by-process claim in the context of the *extrusion* of lighting fixtures with facts similar to the facts of the instant application. In *Herst*, the inventor claimed an “extruded housing for an elongated direct-indirect lighting fixture comprising: an opaque elongated side wall portion . . . an elongated opaque central housing structure . . . and an elongated light baffle plate . . . said sidewall portion, central housing structure and baffle plate being a unitary part fabricated from a single extrusion.” (emphasis added).

In *Herst*, the Board of Patent Appeals and Interferences recognized that “the single

Appl. No. 10/785,316  
Amendment dated October 17, 2005  
In Response to Office Action of May 16, 2005

extrusion construction of the invention greatly simplifies the assembly and manufacture of the fixture and eliminates unsightly seams and leakage points in the fixture housing.” The BPAI distinguished the prior art cited as follows:

[W]e are not persuaded that teachings from the prior art would have suggested the limitations of a “sidewall portion, central housing structure and baffle plate being a unitary part fabricated from a single extrusion.”

As a result, the BPAI reversed the Examiner’s determination and allowed the subject claims.

For similar reasons, the Applicant respectfully submits that the amended claims in the present Application should be allowed. *Tucker, Sr.* discloses a complex arrangement of ribs attached to a shaft using an “interference fit” (*Tucker, Sr.*, col. 10, lines 64-65 and Fig. 6b). The other embodiments include an “overlay” of a single material which surrounds the entire shaft (See, e.g., *Tucker, Sr.*, Figs. 4, 6a), which clearly differs from the Applicant’s claimed invention in that the exterior surface of that shaft comprises one material having a single coefficient of friction.

The disclosed “interference fit” in *Tucker, Sr.* requires female openings in shaft formed to accept (through compression) corresponding ribs of a corresponding male shape. (*Tucker, Sr.*, col. 10, line 64 - col. 11, line 8). No compression is required in the Applicant’s invention and the ribs are not susceptible to separation as in *Tucker, Sr.* because they are extruded with the main body portion of the shaft resulting in a one-piece unit. As in *Herst*, the unitary construction of the present invention results in fewer parts and lesser assembly and manufacturing costs.

Appl. No. 10/785,316  
Amendment dated October 17, 2005  
In Response to Office Action of May 16, 2005

Assuming that the amended claims include a process limitation, if a claim includes structural limitations sufficient to distinguish from the prior art, then the addition of process limitation does not preclude patentability. *See, e.g., In re Garnero*, 412 F.2d 276, 279 n. 8 (CCPA 1969). Similarly, to the extent that process limitations in a product-by-process claim impart or affect physical characteristics of the final product, the physical characteristics must be given weight even if the claim does not explicitly recite such physical characteristics. *See, e.g., Ex Parte Lixiao Wang, Paul J. Miller, Daniel J. Horn and Deborah A. Frank*, 2002 WL 226 966 (Bd. Pat. App. & Interf., Appeal No. 2000-0583). Thus, the unitary nature of the claimed invention with its attendant advantages distinguishes from the prior art.

Finally, to establish obviousness, (1) the prior art itself must suggest or motivate the modification of a reference or the combination of reference teachings, (2) the prior art must teach or suggest a reasonable expectation of success, and (3) the prior art must teach or suggest all of the claim limitations. M.P.E.P. § 2143. The "teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hospital Sys., Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). In this case, there is no motivation or suggestion in the cited prior art to combine teachings, and the prior art does not teach all of the limitations in the amended claims. As a result, the Applicant believes the amended claims to be in condition for allowance.

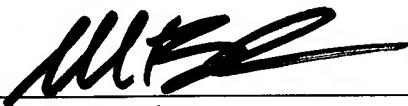
These remarks are believed to be fully responsive to the Office Action mailed May 16, 2005, and are believed to materially advance prosecution of this Application toward immediate

Appl. No. 10/785,316  
Amendment dated October 17, 2005  
In Response to Office Action of May 16, 2005

allowance. Formal allowance of claims 1-10 and 13-22 is therefore courteously solicited.

Respectfully submitted,

PHILLIPS LYTLE LLP

By 

Michael J. Berchou  
Reg. No. 48,233  
3400 HSBC Center  
Buffalo, New York 14203  
Telephone: (716) 847-8400  
Telecopier: (716) 852-6100

*Attorneys for Applicants*

Buffalo, New York  
Dated: October 17, 2005

CERTIFICATE OF MAILING

I certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, this 17th day of October, 2005.

PHILLIPS LYTLE LLP

By

  
Michael J. Berchou, Esq.

Reg. No. 48,233

Signed: October 17, 2005

BFLO Doc. # 1519512.1